

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE  
TTAB

SEPT 22, 98

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re The Valspar Corporation

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Serial No. 75/039,627

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John A. Clifford of Merchant, Gould, Smith, Edell, Welter &  
Schmidt for applicant.

Adam C. Striegel, Trademark Examining Attorney, Law Office  
105 (Thomas G. Howell, Managing Attorney).

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Before Quinn, Walters and Wendel, Administrative Trademark  
Judges.

Opinion by Walters, Administrative Trademark Judge:

The Valspar Corporation has filed a trademark  
application to register the mark VITRAGARD for "interior  
and exterior coatings in the nature of paint."<sup>1</sup>

The Trademark Examining Attorney has finally refused  
registration under Section 2(d) of the Trademark Act, 15

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<sup>1</sup> Serial No. 75/039,627, in International Class 2, filed January 2,  
1996, based on an allegation of use of the mark in commerce, alleging  
first use and first use in commerce as of 1966.

U.S.C. 1052(d), on the ground that applicant's mark so resembles the previously registered marks shown below<sup>2</sup> that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

[vitralite (stylized print)]

for "enamels, varnishes, stains, fillers,"<sup>3</sup>

- VITRA-TILE for "paints, varnishes, and enamels,"<sup>4</sup>
- VITRALON for "enamels, primers and texture coatings for metal surfaces and coatings and linings for metal containers,"<sup>5</sup>
- VITRA-SHIELD for "stipple finish for interior use,"<sup>6</sup> and
- VITRASIL for "silicone enamel for exterior use."<sup>7</sup>

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<sup>2</sup> According to the records of the PTO, all of the cited registrations are owned by The Sherman-Williams Company.

<sup>3</sup> Registration No. 85,177, issued January 30, 1912, in International Class 2. [Renewed for the fourth time as of January 30, 1992, for a period of ten years; Affidavits filed under Sections 12(c), 8 and 15.]

<sup>4</sup> Registration No. 722,763, issued October 17, 1961, in International Class 2. [Renewed for the first time as of October 17, 1981, for a period of twenty years; Affidavits filed under Sections 8 and 15.]

<sup>5</sup> Registration No. 880,334, issued November 11, 1969, in International Class 2. [Renewed for the first time as of November 11, 1989, for a period of ten years; Affidavits filed under Sections 8 and 15.]

<sup>6</sup> Registration No. 1,520,395, issued January 17, 1989, in International Class 2. [Affidavits filed under Sections 8 and 15.]

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

In the analysis of likelihood of confusion in this case, two key considerations are the similarities between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). Considering, first, the goods, we find that applicant's goods are identical to some of registrant's goods (*i.e.*, "paints" recited in Registration No. 722,763) and closely related to the remaining goods recited in registrant's registrations. While several of registrant's recited goods are limited to interior or exterior use, or to use on metal, applicant's goods as identified encompass all such uses.

Turning to the marks, applicant contends that the subject mark, in substantially the same form, was previously registered for the same goods and was inadvertently allowed to expire; that the existence of applicant's now-expired registration is evidence of the coexistence of applicant's mark and registrant's marks for many years without actual confusion; that VITRA suggests the word "vitreous," which applicant contends is suggestive

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<sup>7</sup> Registration No. 1,701,289, issued July 21, 1992, in International

in connection with applicant's and registrant's goods; and that "marks that contain the term 'vitra' for goods of a similar nature are not uncommon." Applicant has submitted the declaration of Kenneth Arthur, applicant's vice president, sales, consumer group, in support of these contentions.

Both applicant's and registrant's marks contain the identical root term, VITRA. We do not find sufficient evidence in the record to conclude that VITRA would be perceived by consumers as a reference to the term "vitreous," or that "vitreous" is suggestive in connection with the identified goods. However, even if we were to find that VITRA is suggestive in connection with the goods involved in this case, suggestive marks are entitled to protection. Further, applicant's contentions that VITRA is a common, and therefore weak, component of applicant's and registrant's marks in view of third-party use or registration of VITRA is unavailing as no acceptable evidence on this point has been made of record.<sup>8</sup>

We cannot conclude that registrant's marks comprise a family of marks as we have no evidence regarding either

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Class 2. [Affidavits filed under Sections 8 and 15.]

<sup>8</sup> In order to make registrations of record, soft copies of the registrations themselves, or the electronic equivalent thereof, i.e., printouts of the registrations taken from the electronic records of the

registrant's marketing of its products under its marks or consumers' perception of registrant's marks. However, we find that each of registrant's marks contains the root term VITRA followed by a suggestive or arbitrary suffix. The format of applicant's mark is identical in this regard. Applicant's mark is likely to be perceived by consumers as another coating product in registrant's line of products, which include several different types of coatings.

We find that applicant's mark, VITRAGARD, is sufficiently similar in its overall commercial impression to each of registrant's cited registrations, VITRALITE and design, VITRA-TILE, VITRALON, VITRA-SHIELD AND VITRASIL, that the contemporaneous use on the same and closely related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

With regard to applicant's assertion that it is aware of no instances of actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant, we note that, while a factor to be considered, the absence or presence of actual confusion is of little probative value where we have little evidence pertaining to the nature and extent of the use by applicant and registrant. Moreover, the test under Section 2(d) is not

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actual confusion but likelihood of confusion. *See, In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-1027 (TTAB 1984); and *In re General Motors Corp.*, 23 USPQ2d 1465, 1470-1471.

Decision: The refusal under Section 2(d) of the Act is affirmed.

T. J. Quinn

C. E. Walters

H. R. Wendel  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board

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*See, Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992).